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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,336

05/25/2007

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EXAMINER

MOORE, WALTER A

ART UNIT

PAPER NUMBER

1794

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/582,336	<b>Applicant(s)</b> KAKUDO ET AL.	
	<b>Examiner</b> WALTER MOORE	<b>Art Unit</b> 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **RESPONSE TO AMENDMENT**

### ***Acknowledgment of Documents***

1. Claims 1-9, 11-20 are pending. Claims 10 and 21-22 were canceled and claims 1-9, 11-12, 14-20 were amended in the response filed on 28 July 2009.
2. The amendments to the specification, filed on 28 July 2009, have been entered.

### ***Information Disclosure Statement***

3. As stated in the office action mailed on 28 April 2009, the information disclosure statement filed 05/25/2007 fails to comply with 37 CFR 1.98(a)(2). Applicant has not corrected the cited deficiency.

### ***Withdrawn Objections and Rejections***

4. The objection to claim 13 made of record in the office action mailed on 28 April 2009 are withdrawn due to applicant's argument, filed on 28 July 2009.
5. The 35 USC 112 rejections of claims 1, 2, 9, and 23 made of record in the office action mailed on 28 April 2009 are withdrawn due to applicant's amendment, filed on 28 July 2009.
6. The 35 USC 102 rejections of claims 1-10, 16 and 23 as being anticipated by Kitajima as evidenced by Oono made of record in the office action mailed on 28 April 2009 are withdrawn due to applicant's amendment, filed on 28 July 2009.

7. The 35 USC 102 rejections of claims 1-6, 9-15, and 21-23 as being anticipated by Hoppy as evidenced by Oono made of record in the office action mailed on 28 April 2009 are withdrawn due to applicant's amendment and argument, filed on 28 July 2009.
8. The 35 USC 103 rejections of claims 5, 11, 14, 16-18 as being obvious over Kitajima or Hoppy as evidenced by Brewing Techniques made of record in the office action mailed on 28 April 2009 are withdrawn due to applicant's argument, filed on 28 July 2009.
9. The 35 USC 103 rejections of claims 19-22 as being obvious over Kitajima in view of Hoppy made of record in the office action mailed on 28 April 2009 are withdrawn due to applicant's argument, filed on 28 July 2009.

### **REJECTIONS**

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

11. Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is indefinite because the meaning of the phrase "other starting materials" is unclear. The claim fails to indicate what other components are appropriate starting materials.

***Claim Rejections - 35 USC § 102***

12. Claims 1-6, 9, 12, 15, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by The Webtender, “CarBomb” (retrieved on 11/16/2009, published on 10 February 2003), as evidenced by the following: “Guinness” (retrieved on 11/17/2009, published on 16 April 2003); Drinkmixer for Jameson’s Whiskey (retrieved on 11/17/2009, published on 19 October 2003); Drinkmixer for Guinness Stout (retrieved on 11/17/2009, published on 9 October 2003); and Drinkmixer for Bailey’s Irish Cream (retrieved on 11/17/2009, published on 11 October 2003).

13. Regarding claims 1-2 and 9, The Webtender teaches a malt fermented beverage (Carbomb) comprising an alcohol containing material made of fermented barley (Guinness stout) and an alcohol containing distillate made from barley (Jameson’s Whiskey).

14. Regarding the alcohol content (claim 1) and volume ratio (claim 2), The Webtender teaches mixing 13 oz of component A (Guinness) with 1 oz of component B (Whiskey) resulting in a volume ratio of 13:1. The alcohol content of component B (Jameson’s) is 40% (see Drinkmixer Jameson’s) and alcohol content of component A (Guinness Stout) is 4.1% (see Drinkmixer Guinness stout) and. Therefore, a ratio of the alcohol content of components 9.75:1 (Whiskey:Beer =  $.40/.041 = 9.75:1$ ).

15. Regarding claims 3-6, Guinness is beer made with malt, barley, hops, and water (see “Guinness”, p. 1, Brewing Materials section).

16. Regarding claims 12 and 15, the limitations “is distilled in a batch distiller” (claim 12) and “is distilled in a continuous distiller” (claim 15) are method limitations and do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless

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Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

17. Regarding claim 19, The Webtender teaches using Jameson's Whiskey, which has 40% alcohol (80 proof, Drinkmixer for Jameson's Whiskey).

18. Regarding claim 20, The Webtender teaches mixing 13oz of component A (Guinness), 1oz component B (Whiskey), and 1oz Irish cream (Baileys). This results in a alcohol percentage of about 7.4% (Calculation:  $C_a V_a + C_b V_b + C_{\text{Irish}} V_{\text{Irish}} = C_t V_t = 4.1\%(13\text{oz}) + 40\%(1\text{oz}) + 17\%(1\text{oz}) = 1.103$ ;  $1.103/15\text{oz} = 0.007353 = 7.353\%$ ).

### ***Claim Rejections - 35 USC § 103***

19. Claims 1-6, 9, 11-16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppy de Happy-to ("Hoppy de Happy Dokuhon", Kabushiki Kaisha Asupekuto; 22 August, 2000) hereinafter "Hoppy", in view of either Shinozaki et al., JP 60241883 (English Abstract) or Global Gourmet (retrieved on 11/21/2009, published on 10/04/2003), as evidenced by Japan – Taxes on Alcoholic Beverages.

Please note the examiner has requested a human translation of the Hoppy document.

Regarding claims 1, 2, and 9, Hoppy teaches malt fermented beverage comprising two components. Component A is an alcohol containing material made of barley (Hoppy, translation p. 2, second from last paragraph). Component B is an alcohol containing distillate (shochu, p. 2, last paragraph).

Regarding the alcohol ratio of claim 1 and claim 19: Hoppy teaches the shochu is 25 degree. The examiner notes the applicant's provided translation of the Japanese document

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translated text box number 1 on page 1 as 25 proof. However, the document actually states 25 degree. In Japanese tax law 25 degree alcohol equates to percent alcohol (Japan – Taxes on Alcoholic Beverages, p. 6, paragraph 2.3 and Shochu A table). Hoppy teaches component A has an alcohol content of 0.8% (translation p. 2, 3<sup>rd</sup> paragraph from bottom). Therefore, a ratio of the alcohol content of the components is 31.25 (Shochu:Hoppy =  $31.25 = .25/.008$ ). In the event that the translation of Hoppy (provided on 05/25/2007) is correct and the Hoppy has a proof of 25, which is 12.5% alcohol, a ratio of alcohol content is 15.625 (Shochu:Hoppy =  $31.25 = .125/.008$ ).

Regarding the volume ratio of claim 2: Hoppy does not expressly teach the volume ratio of components A (Hoppy) and component B (shochu). However, substitution of the values given in Hoppy results in a concentration volume equation results in a volume ratio of 10:1 (Calculation:  $C_aV_a + C_bV_b = C_tV_t$ ;  $0.008(a) + .25(b) = .03(a+b)$ ;  $0.22b = 0.022a$ ;  $a/b = 10$ ).

Regarding claims 1, 2, 11, 13, 14, and 16, Hoppy does not teach the alcohol containing distillate (shochu) is made from wheat.

Shinozaki teaches an otsu mugi shochu that has a having mellow and rich flavor Shinozaki teaches the shochu is made from wheat. It would have been obvious to one of ordinary skill in the art at the time of invention to use a wheat shochu, as taught in Shinozaki, to obtain a malt beverage having otsu mugi shochu because the otsu mugi shochu has a mellow and rich flavor.

In the alternative, to Hoppy in view of Shinozaki, Hoppy teaches discloses the claimed material except for the materials used to make component B (shochu). Global Gourmet teaches shochu is made from various grains including wheat. It would have been obvious to one having

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ordinary skill in the art at the time the invention was made to select shochu made from wheat, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. MPEP 2144.07.

Regarding claims 3-5, Hoppy teaches component A (Hoppy) comprises malt, starch (cornstarch), and hops (translation, p. 3, second paragraph). Hoppy does not expressly teach component A comprises water. However, Hoppy teaches the ingredients are boiled together (translation, p. 3, second paragraph) and brewed in the same way as beer (translation, p. 2, second to last paragraph). Therefore, Hoppy at least implies component A comprises water. In the alternative, Examiner takes official notice that beer comprises water.

Regarding claim 6, Hoppy teaches component A (Hoppy) is beer (translation p. 1, ln. 5).

Regarding claims 12, 13, 15, the limitations “is distilled in a batch distiller” (claim 12); “is otsu-rui shochu” (otsu-rui shochu means produced in a batch distiller, claim 13); and “is distilled in a continuous distiller” (claim 15) are method limitations and do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding claim 20, Hoppy teaches the alcohol content of the malt beverage is between 3% and 8% (translation p. 1, ln. 15-16).



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20. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Webtender, “CarBomb”, as evidenced by “Guinness” and Drinkmixer for Jameson’s Whiskey (retrieved on 11/17/2009, published on 19 October 2003); Drinkmixer for Guinness Stout (retrieved on 11/17/2009, published on 9 October 2003); and Drinkmixer for Bailey’s Irish Cream (retrieved on 11/17/2009, published on 11 October 2003), as applied to claims 1-6, 12, 15, and 19-20 above, and further in view of Tripp et al., USPN 5,618,572.

The Webtender is relied on as above.

The Webtender does not teach the malt proportion of component A.

Tripp is drawn to preparing beer and malt beverages (Abstract). Tripp teaches changing the malt proportion of beer changes the flavor profile of the final product (col. 8, ln. 67 to col. 9, ln. 1). Tripp suggests malt proportions from 26% (21/79 malt/dextrose, col. 8, ln. 63) to 127% (56:44 malt/dextrose, col. 9, ln. 1-2). Tripp also suggests using a beer comprising between 80-100% malt (col. 4, ln. 5). Tripp teaches the flavored malt beverages minimize the consumer sensation of fullness, meaning they are drinkable and refreshing (col. 9, ln. 30-31). Furthermore, Tripp suggests the malt base can be used as a mixture “for all manner of liquors” (col. 10, ln. 18-21).

Therefore, the flavor profile of the final product is deemed to be a result effective variable with regard to the malt proportion. It would require routine experimentation to determine the optimum value of a result effective variable, such as malt proportion, in the absence of a showing of criticality in the claimed malt proportion. One of ordinary skill in the art at the time of invention would have been motivated to change the malt proportion, as taught

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by Tripp, to obtain a final product having acceptable drinkability and taste (col. 9, ln. 30-31).

Furthermore, Tripp expressly suggests malt proportion ranges, which overlap the claimed ranges.

21. Claims 7, 8, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppy de Happy-to (“Hoppy de Happy Dokuhon”, Kabushiki Kaisha Asupekuto; 22 August, 2000) hereinafter “Hoppy”, in view of either Shinozaki et al., JP 60241883 (English Abstract) or Global Gourmet (retrieved on 11/21/2009, published on 10/04/2003), as evidenced by Japan – Taxes on Alcoholic Beverages, as applied to claims 1-6, 9, 11-16, 19, and 20 above and further in view of Tripp et al., USPN 5,618,572.

Hoppy in view of either Shinozaki or Global Gourmet is relied on as above.

Hoppy in view of either Shinozaki or Global Gourmet does not teach the malt content of component A.

Regarding claims 7, 8, and 17-18, Tripp is drawn to preparing beer and malt beverages (Abstract). Tripp teaches changing the malt proportion of beer changes the flavor profile of the final product (col. 8, ln. 67 to col. 9, ln. 1). Tripp suggests malt proportions from 26% (21/79 malt/dextrose, col. 8, ln. 63) to 127% (56:44 malt/dextrose, col. 9, ln. 1-2). Tripp also suggests using a beer comprising between 80-100% malt (col. 4, ln. 5). Tripp teaches the flavored malt beverages minimize the consumer sensation of fullness, meaning they are drinkable and refreshing (col. 9, ln. 30-31). Furthermore, Tripp suggests the malt base can be used as a mixture “for all manner of liquors” (col. 10, ln. 18-21).

Therefore, the flavor profile of the final product is deemed to be a result effective variable with regard to the malt proportion. It would require routine experimentation to

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determine the optimum value of a result effective variable, such as malt proportion, in the absence of a showing of criticality in the claimed malt proportion. One of ordinary skill in the art at the time of invention would have been motivated to change the malt proportion, as taught by Tripp, to obtain a final product having acceptable drinkability and taste (col. 9, ln. 30-31). Furthermore, Tripp expressly suggests malt proportion ranges, which overlap the claimed ranges.

Regarding the wheat spirit of claim 18, as discussed above, both Shinozaki and Global Gourmet teach the shochu is made from wheat.

Regarding claim 17, the limitation “is otsu-rui shochu” (otsu-rui shochu means produced in a batch distiller, claim 13) is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

### ***Response to Arguments***

22. Applicant’s arguments, see remarks section 7, filed 28 July 2009, with respect to 1-10, 16, and 23 over Kitajima and claims 1-6, 9-15, and 21-23 Hoppy under 35 USC 102(b) have been fully considered and are persuasive. The rejections have been withdrawn.

23. Applicant’s arguments, see remarks section 8, filed 28 July 2009, with respect to 5, 11, 14, and 16-18 and 19-22 under 35 USC 103(a) over Kitajima as evidenced by Brewing Techniques have been fully considered and are persuasive. The rejections have been withdrawn.

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24. Applicant's arguments with respect to claims 5, 11, 14, and 16-18 under 35 USC 103(a) over Hoppy as evidenced by Brewing Techniques have been considered but are moot in view of the new ground(s) of rejection.

The examiner notes the applicant's ratio calculations. However, examiner provided calculations above demonstrating how the references meet the claimed limitations.

25. Applicant's arguments with respect to claims 19-22 under 35 USC 103(a) over Kitajima in view of Hoppy have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

26. Do to the new grounds of rejection this action is NON-FINAL.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WALTER MOORE whose telephone number is (571) 270-7372. The examiner can normally be reached on Monday-Thursday 9:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WM/  
Walter Moore, Examiner AU 1794  
11/21/2009

/Alicia Chevalier/  
Primary Examiner, Art Unit 1794